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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/805,046 | 03/14/2001 | Naohito Takae | 1614.1138 | 1661 |

21171 7590 08/12/2004

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| EXAMINER |
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GARG, YOGESH C

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| ART UNIT | PAPER NUMBER |
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3625

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,046

Applicant(s)

TAKAE ET AL.

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 and 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment and election of species requirement

1.1. Applicant's election without traverse of invention I of claims 1-16 in the reply filed on May 06, 2004 is acknowledged.

1.2. Applicant's election with traverse of species of claims 3-7 in the reply filed on May 06, 2004 is acknowledged. The traversal is on the ground(s) that claim 8 which depends upon claim 3 should also be included in the species of claims 3-7 elected because if non-generic claim 3, which is dependent on claim 1, is allowable claim 8 will also be allowable. This is not found persuasive because for the following reasons:

(i) Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a). Therefore, if claim 3 is allowable then all its dependent claims including claim 8 will be entitled to consideration even though it belongs to a different species. This was already indicated in the earlier Office action under paragraph (9).

(ii) The search for Species of claims 3 and 8 and 3-7 is divergent. The search for the steps of claim 8 would involve searching the steps of selecting an option to collect the product to dispose of, obtaining a collection fee for each product and distributing a collection request sheet, which do not overlap with the limitations in claims 4-7. Thus it can be clearly seen that

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the species of claims 3-7 and species of claims 3 and 8 are different and would require distinct and unduly burdensome search strategies on the part of the examiner.

The requirement is still deemed proper and is therefore made FINAL.

1.4. Claims 8-12 and 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention there being no allowable generic or linking claim. Claims 1-7 and 13-16 of the elected species have been amended. Currently claims 1-7 and 13-16 are pending for examination.

Specification

2 The amendment to abstract filed on May 06, 2004 is acknowledged and entered.

Drawings

3. Amended drawings with changes to FIGS. 5, 10, 11, and 12 are acknowledged, approved and entered.

Claim objections

4 Claim 6 recites the term " step (f)" in line 6 and "step (g)" in line 8 of the claim which lack antecedent because terms "(f)" and "(g)" in lines 3 and 5 have been deleted due to current amendment. The examiner suggests to replace " step (f)" in line 6 and "step (g)" in line 8 of the

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claim by---said step of searching the purchased product identification and said step of extracting the customer information respectively. Claim 6 will be treated further on merits accordingly.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5.1. Claims 2 (currently amended), and 4 (currently amended) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. As best understood by the examiner, claim 2 is directed to the step of deleting information about a purchased product on receiving a request from a customer in the earlier step of conducting a request process of claim 1 and claim 4 is directed to notifying the customer selectable places on the customer terminal to receive a repaired product and including the selected place by said customer in said repair request sheet distributed to said repair person. Claims 2 and 4 shall be further treated on merits accordingly.

6. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that,

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in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

7 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.1. Claims 1-3, 5, 7 and 13-16 are rejected under 35 U.S.C. 102(E) as being anticipated by Wallis et al. (US Publication Number: 2001/0051884 A1), hereinafter, referred to as Wallis.

Regarding claim 1, Wallis teaches 1a method for managing product information, said method comprising :

retrieving warranty information, corresponding to a purchased product identification received from a customer-terminal used by a customer, from a sales information management database managing the purchased product identification identifying a product that the customer purchased and the-warranty information showing a warranty of the product, informing selectable request items with the retrieved warranty information to the customer-terminal, and conducting a request process corresponding to one of the selectable request items, which is indicated from the customer-terminal (see at least page 5, paragraph 0049, " *With reference with FIG. 5, an*

embodiment of a purchaser account 230 is shown. A general page 500 allows the purchaser 75 to access and view other documents contained within the purchaser account 230. The purchaser is provided with access to a Service Plans List document 510 which identifies the warranty plan covering each product purchased by the purchaser 75. From the Service Plans List document 510, the host system 10 allows the purchaser 75 to access a Service Plan Canceling document 512, a Service Plan Renewal document 514, a Purchase Service Plan document 516, a Troubleshooting document 518, and a Repair Order document 520. Note: Service Plant list 510 includes the warranty information which is retrieved from database 45 [see Fig.1, and page 1, paragraph 0036 and this database corresponds to sales information management database because in Wallis database 45 can include several databases including information related to purchased products, warranties, repair plans, etc.] when the purchaser 75 identifies a Purchaser account 230 [see FIG.2] and the previously purchased product and prompts the purchaser to select one item from selectable list of items 510 [Fig.5] and based on the customer's selection the system conducts the process based upon the item selected by the purchaser from his terminal [see FIG.1 for the purchaser's terminal and architecture of the system]. See also paragraphs 0036-0047, pages 3-5.).

Regarding claim 2, Wallis teaches (see rejection under second paragraph of 35 U.S.C. 112 above in serial number 2) deleting information about a purchased product on receiving a request from a customer in the earlier step of conducting a request process of claim 1 (see at least FIG.5, “ *Service Plan canceling 512*” and paragraphs 0049 and 0050 on pages 5-6. Canceling a service plan by the purchaser corresponds to deleting information about a purchased product on receiving a request from a customer.).

Regarding claim 3, Wallis further teaches that the method as claimed in claim 1, wherein said sales information management database manages the customer information concerning

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the customer by corresponding the customer to the purchased product identification of the product that the customer purchased (see at least paragraphs 0036-0047, pages 3-5), and said conducting a request process comprises : distributing a repair request sheet including repair information for a repair person who is selected by searching from the sales information management database based on the customer information corresponding to the purchased product identification received from the customer-terminal when one of the' selectable request items, which is indicated from the customer-terminal, shows a request to repair the product that the customer purchase and maintaining repair contents conducted by the repair person and the purchased product identification of a repaired product as repair history information to a repair history database (see at least paragraph 0042, page 4-paragraph 0047, page 5. Note: The repair center 95 and repair request/repair report corresponds to a repair person and repair request sheet respectively. Database 45 stores the repair history information [see FIG.1 and paragraph 0036, page 1]).

Regarding claim 5, Wallis further teaches that the method as claimed in claim 3, wherein said-step (b) informing selectable request items comprises :

checking whether or not a same repair is conducted within a predetermined period, by searching for the repair history information from said repair history database based on the purchased product identification received from the customer, and informing said warranty information and said request items with a result of said checking to the customer (see at least paragraph 0037, page 3-paragraph 044, page 5).

Regarding claim 7, Wallis further teaches that the method as claimed in claim 3, further comprises : searching for the repair history information from the repair history information

database based on the purchased product identification when a request message including the purchased product identification and requesting a repair status is received from the customer', and sending the repair status created based on the searched repair history information to the customer-terminal (see at least paragraph 0037, page 3-paragraph 044, page 5).

Regarding computer readable medium and apparatus claims 13-16, their limitations are closely parallel to the limitations of claims 1 and 3 are therefore analyzed and rejected on the same basis as being anticipated by Wallis.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8.1. Claim 4 is rejected under 35 U.S.C. 103(a) as being obvious over Wallis in view of Official Notice .

Regarding claim 4, Wallis teaches a method for managing product information as analyzed and disclosed in claim 1 above. Wallis further teaches selecting an appropriate repair center 95 and a parcel delivery service 85 from the database corresponding to a customer and including the selected place for receiving the repaired product in the repair sheet to the repair person (see at least paragraph 0042-0044, pages 4-5) but does not disclose notifying the customer with the information on places, which are selectable, to receive a repaired product (see rejection under second paragraph of 35 U.S.C. 112 above in serial number 2 for the limitations of claim 4). The examiner takes Official Notice of both the concept and the benefits of notifying the customer with the information on places, which are selectable, to receive a repaired product. It is generally practiced concept to ask customer his choice out of the number of choices available as which warehouse/location he would like to receive the ordered item, e.g. while renting a car the customer is offered a number of possible locations and then customer chooses the best possible location per his convenience, or ordering consumables/items online the customer is prompted to select one location out of a number of available choices. In view of the Official Notice it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to include the concept of notifying the customer with the information on places, which are selectable, to receive a repaired product because it is a gesture of goodwill to the customer to allow him the choice to pick up most convenient place of the available places to received the repaired item and this gesture of goodwill would help the suppliers to get repetitive business from the customer.

8.2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallis in view of Lipton. Gigi M; "Product traceability: A guide for locating recalled manufactured goods"; Quality

Congress. ASQ's.....Annual Quality Congress Proceedings. Milwaukee, 1998, pg. 423, 9 pgs; extracted from Proquest database on Internet on 8/3/2004, hereinafter referred to as Lipton.

Regarding claim 6, Wallis teaches a method conducting a repair request process from a customer as analyzed in claim 3 above. Wallis teaches searching the purchased product identification corresponding to the repair contents from repair history database and extracting customer information from information database as already analyzed in claims 3-5 above. Wallis does not expressly teach that the repair contents are related to recall of products and informing the recall information to recall a product to the customers, though it is generally a well-known process practiced for many years earlier to the applicant's invention, e.g. car or appliance manufacturers, when even they found an item to be defective, issue recall notices to the customers. Lipton discloses that recall of defective repair contents and informing the customers about these recalls. In view of Lipton, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to include data about recalls in the repair history and when recall event happens to inform customers because this process of storing recall information and informing the customers , as already notoriously well –known, will enable the customers to inform them online (communication online being already taught in Wallis) so that they can take action to get their products repaired before an uneventful situation can arise.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Press release; " PinPoint Corporation Establishes LocateIt! Partner Program to Provide Worldwide System Integrations and Support Services to 3D-iD Local Positioning System Installations "; Business/Technology Editors; Business Wire; New York; Aug 3, 1999; pg.1, extracted from Proquest database on Internet on 8/3/2004, discloses (see page 3, paragraph 6 under the head Trak Tek, " *TrakTek's flagship product, Merlin-an automated locating, tracking.....application-collects, manages and integrates its own database of location and utilization information and client information.....product suite can be used by operational personnel.....suppliers to manage product recalls.....*") locating information about products from a database and helping suppliers to manage recall programs.

(ii) WO 99/21610 to Finch discloses locating and tracking information by accessing a centralized database through the Internet (see at least page 3, lines 1-19).

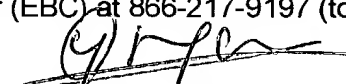
(iii) US Patent 6,604,681 B1 to Burke et al. discloses a computerized method and system enabling consumers to search and retrieve information about items from a database via an electronic communication network (see at least abstract).

(iv) US Publication numbers 2002/0111884 A1 to Groat et al. (see at least paragraphs 0029, page 3-0042, page 4) and 20040019535 to Perkowski (see at least paragraph 0127, page 13 and paragraph 0238, page 25) disclose a computerized method and system for retrieving information on a product using a product identification code and that information includes warranty information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
August 2, 2004